

## **REMARKS**

### **I. Status of Claims:**

Claims 16, 17 and 19-32 are pending and stand rejected under various sections of 35 U.S.C. Claim 18 is canceled. Claims 33-35 have been added. Support for claims 33-35 is found throughout the specification and drawings. No new matter is added.

### **II. Rejection Under 35 U.S.C. § 112:**

Claim 24 is deemed indefinite for use of the phrase, "as viewed in plan." The phrase has been deleted rendering the rejection moot. Reconsideration and removal of the rejection of claim 24 under 35 U.S.C. § 112, second paragraph, are respectfully requested.

### **III. Rejections Under 35 U.S.C. § 102(b):**

Claims 16-28 and 30-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Canadian Patent No. 1,219,642. Claim 16, as amended, requires the claimed electrode have at least one uncontacted current-equalizing conductor that lacks a connecting element. These conductors perform the important function of dispersing the current evenly over an electrode's surface to improve consistency of function. As conceded by the examiner, the Canadian '642 Patent shows electrodes with elements that are *all* capable of being contacted by an electrode. None of the conductors disclosed in the Canadian '642 patent are uncontacted current-equalizing conductors that can equalize the current over the electrode surface. As such, the '642 Patent neither shows nor suggests an electrode having at least one uncontacted current-equalizing conductor surface. To the contrary, the '642 Patent discloses a plurality of conductors, each of which is designed to be

connected to or receive current from a current source, and none of which can be used to equalize the distribution of current over the electrode. Accordingly, reconsideration and removal of the rejection of claim 16, as amended, under 35 U.S.C. § 102(b) are respectfully requested.

Claims 17, 19-28 and 30-32 depend, directly or ultimately, from claim 16 and are allowable for the reasons given above. Reconsideration and removal of the rejections of claims 17, 19-28 and 30-32 under 35 U.S.C. § 102(b) are respectfully requested.

**IV. Rejections Under 35 U.S.C. § 103:**

Claim 29 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Canadian Patent No. 1,219,642. Applicants respectfully traverse the rejection. Claim 29 depends ultimately from base claim 16, which is allowable for the reasons given above.

Applicants respectfully disagree with the conclusion that “it would have been obvious to modify the thicknesses of the electrodes to within such a range as an obvious design choice.” There is no teaching, motivation or suggestion in the ‘642 Patent to modify the radial widths of the electrodes to provide radially-spaced electrodes having substantially equal surface areas. The motivation for doing this is derived from one of the purposes of Applicants’ invention--to provide a means to equalize the current over an electrode. Absent this desired function, there would be no reason to modify the electrodes of the ‘642 Patent to arrive at Applicants’ invention. The conclusion is the result of hindsight reasoning and should not properly be made. Accordingly, the rejection of claim 29 under the rationale advanced is improper. Applicants respectfully request reconsideration and removal of the rejection of claim 29 under 35 U.S.C. § 103(a).

**V. New Claims:**

Claims 33-35 are method claims the use the features of the electrode of claim 16 to perform the function of equalizing current. Nothing in the '642 Patent shows or suggests such a method. Entry and consideration of claims 33-35 are respectfully requested.

**VI. Substance of April 20, 2006 Interview:**

On behalf of the Applicants, counsel thanks the examiner for the opportunity to explain the novel features of the invention as described and claimed in the application. It should be noted that no exhibits were used other than the initial response to the pending office action. All the claims were discussed including new claims 33-35 drawn to a method of equalizing the current in a medical electrode. No specific prior art was discussed other than occasional references to what is generally known in the art.

The principal proposed amendment was made to the uncontacted conductor surface limitation in claim 16. The limitation is further defined to be a "current-equalizing" conductor surface. The purpose of this conductor is to equalize the current traveling through the electrode when introduced through one of the contacted conductor surfaces. The function is derived from the unique structural arrangement of conductors and is further exemplified in the method claims, 33-35. The examiner was in general agreement that the prior art did not disclose or teach such an arrangement, and more specifically, did not teach such a method of current equalization for an electrode.

The only other pertinent matter discussed was the examiner's decision to remove the finality of the pending office action so as to advance the application to allowance. The examiner informed counsel that the new amendments and new

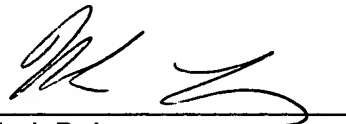
claims would be given further consideration. If there are any remaining issues with respect to the allowability of the claims in their currently amended form, the examiner would suggest additional claim amendments in the next office action. In general, the examiner believes there is allowable subject matter, particularly with respect to method claims.

**VII. Conclusion:**

For the foregoing reasons, all the pending claims are considered to define patentably over the prior art. If, for any reason, the Examiner is inclined to further reject any of the claims, Applicants request that counsel be contacted to resolve any remaining issues. Reconsideration is requested and favorable action is solicited.

Respectfully Submitted

LORUSSO & ASSOCIATES



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The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being sent via U.S. First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450-this 22nd day of May 2006.

A handwritten signature in black ink, appearing to read 'Mark D. Lorusso', written over a horizontal line.

Mark D. Lorusso